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OFFICE OF PETITIONS

In re Application of :
SCOTT A. FIELD :
Application No. 09/489,192 : DECISION ON PETITION
Filed: January 20, 2000 :
Attorney Docket No. MSI-407US :

This is a decision on the petition under the unavoidable provisions of 37 CFR 1.137(a), filed May 22, 2006, to revive the above-identified application.

The petition is **DISMISSED**.

Any further petition to revive must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The application became abandoned for failure to submit formal drawings in a timely manner in reply to the Notice of Allowability, mailed September 7, 2005, which set a period for reply of three (3) months. Accordingly, this application became abandoned on December 8, 2005.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d). **The instant petition lacks items (1) and (3).**

Petitioner states that the Corrected Drawings required on the Notice of Allowability were timely filed on March 24, 2004 as "Replacement Drawing Sheet 2" in response to the Office Action dated November 28, 2003. Applicant's representative contacted the USPTO on September 15, 2005 and had the USPTO correct their records and make an entry in the Transaction History in PAIR for the application indicating "9-15-2005 Correction - Drawing Not Required."

This argument is not persuasive. USPTO does not dispute that applicant filed a drawing correction on March 24, 2004. However, these drawings filed on March 24, 2004 are not responsive to the requirement set forth in the Notice of Allowability.

The Notice of Allowability mailed on September 7, 2005 set forth the requirement that CORRECTED DRAWINGS (as "replacement sheets") must be submitted including changes required in the attached Notice of Draftsperson's Patent Drawing Review (PTO-948). The Notice of Draftsperson's Patent Drawing Review (PTO-948) was mailed as an attachment to the Notice of Allowability on September 7, 2005 and clearly states that the drawing(s) filed on March 24, 2004 was objected to by the draftsperson; thereby necessitating the requirement in the Notice of Allowability to supply a correction to the drawings filed on March 24, 2004.

No written communication was filed in the application to traverse any requirement found in the Notice of Allowability until the petition to withdraw the abandonment was filed on April 25, 2006¹. The drawings filed on March 24, 2004 are not a reply in compliance to the requirements set forth in the Notice of Draftsperson's Patent Drawing Review (PTO-948) and the Notice of Allowability mailed on September 7, 2005.

The petition states that on September 15, 2005, applicant's representative contacted the USPTO and had cause an entry into the transaction history in PAIR to indicate "Correction – Drawing NOT Required" to be entered into the electronic transaction history for the application. This egregious action caused an incorrect entry to be made into the file transaction history. Petitioner and/or applicant should refrain from such actions. All business with the USPTO should be transacted in writing. If applicant disagrees with a requirement, applicant should timely reply in writing (see 37 CFR 1.2) to traverse any objectionable requirement(s). The action of the USPTO will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

Conclusion

With regard to item (1), petitioner has not submitted the required reply in terms of Corrected Drawings in compliance with the Notice of Draftsperson's Patent Drawing Review (PTO-948) and Notice of Allowability mailed on September 7, 2005.

With regard to item (2), the petition fee of \$500 has been accepted.

With regard to item (3), there is no satisfactory showing that the delay in filing the required reply meets the "unavoidable" standard pursuant to 37 CFR 1.137(a).

If petitioner cannot provide the evidence necessary to establish unavoidable delay, or simply does not wish to, petitioner may wish to consider filing a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned

¹ The petition to withdraw the holding of abandonment filed on April 25, 2006 was dismissed on May 1, 2006. In response, the instant petition to revive under 37 CFR 1.137(a) was filed on May 22, 2006.

application without a showing that the delay in prosecution or in late payment of the issue fee was "unavoidable." This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the \$1,500 petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

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Telephone inquiries concerning this decision should be directed to Amelia Au at (571) 272-7414.



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Office of Petitions